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OFFICE OF PETITIONS

In re Application of :
O'Rourke, Dean, Wang, Van Antwerp, :
Roth, and Knowlton : DECISION REFUSING STATUS
Application No. 09/893,373 : UNDER 37 CFR 1.47(a)
Filed: 26 June, 2001 :
Attorney Docket No. MS1-575US :

This is in response to the petition filed under 37 CFR 1.47(a) on 16 January, 2002.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.

FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.
Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

The above-identified application was filed on 26 June, 2001, with a declaration naming Bret P. O'Rourke, Dawson F. Dean, Chih-Kan Wang, Mark D. Van Antwerp, David J. Roth, and Chadd B. Knowlton as joint inventors and signed by all joint inventors except Wang on behalf of themselves and joint inventor Wang.

Accordingly, on 21 August, 2001, a Notice to File Missing Parts of Nonprovisional Application was mailed, requiring the statutory basic filing fee, additional claim fee(s), an oath or declaration bearing the signature of Chih-Kan Wang, and a surcharge for their late filing. A two (2)-month period for reply was set. In response, on 16 January, 2002, the present petition was filed,

accompanied by a three (3)-month extension of time fee, the basic filing fee, additional claim fee(s), and the late filing surcharge. Petitioners assert that joint inventor Wang cannot be found despite diligent efforts.

A grantable petition under 37 CFR 1.47(a) requires:

(1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);

(2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;

(3) the petition fee;

(4) a surcharge of \$130 or \$65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and

(5) a statement of the last known address of the non-signing inventor.

The petition lacks items (1) and (2). In regards to item (1), petitioners have not provided proof that diligent efforts have been made to locate the non-signing inventor.¹ Petitioners must show proof that a copy of the application (specification including claims, drawings, if any, and the Declaration) were sent or given to the non-signing inventor for review.² Petitioners should provide a copy of the cover letter transmitting the application papers to the non-signing inventor or details given in an affidavit or declaration of facts by a person having first hand knowledge of the details. It is noted that a brief Internet search suggests that Wang may now be living at another address in Redmond, WA.

In the event that the application is returned as undeliverable by the post office, petitioners should provide a copy of the envelope showing that the application sent to the last known address of the non-signing inventor was returned as undeliverable by the post office. Details of the efforts made to locate the non-signing inventor should be set forth in an affidavit or declaration of facts by a person having first hand knowledge of the details.

¹MPEP 409.03(d).

²Id.

In the event that the non-signing inventor refuses to sign the declaration, petitioners must present proof thereof. If there is a written refusal, a copy of the written refusal should be submitted with any renewed petition. If the refusal was made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of facts.

In regards to item (2), the declaration as filed does not state the citizenship of non-signing inventor Wang.³ A statement of the inventor's citizenship is a statutory requirement and cannot be waived.⁴ Additionally, the declaration filed on 26 June, 2001 does not state that the person(s) making the oath or declaration acknowledge the duty to disclose to the Office all information known to the person(s) to be material to patentability as defined in 37 CFR 1.56. Rather, the declaration filed on 26 June, 2001, incorrectly acknowledges a duty to disclose all information material to examination of the application. A new oath or declaration in compliance with 37 CFR 1.63 and 1.67, signed by all of the signing inventors on behalf of themselves and the non-signing inventor, must be submitted with any renewed petition.

The petition fee will be charged to counsel's deposit account, No. 12-0769, as authorized by the fee transmittal filed with the present petition.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
 Box DAC
 Washington, D.C. 20231

By FAX: (703) 308-6916
 Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
 2201 S. Clark Place
 Arlington, VA

³MPEP 605.01.

⁴35 U.S.C. § 115, MPEP 605.01.

Telephone inquiries related to this decision should be directed to the undersigned at 703-308-6918.

A handwritten signature in cursive script, appearing to read "D Wood".

Douglas I. Wood
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy